

Appl. No. 09/864,836
Amtd. Dated December 8, 2003
Reply to Office Action of July 14, 2003

• • R E M A R K S / A R G U M E N T S • •

The present Preliminary Amendment is being filed together with a Request for Continued Examination.

In Advisory Action mailed November 18, 2003 the Examiner indicated that the amendments submitted for the claims in applicant's Supplemental Amendment After Final filed November 3, 2003 raised new issues which would require further consideration and/o search.

Accordingly, it is believed that the amendments presented herein for the claims will reopen the prosecution in order to address these new issues.

By the present Preliminary Amendment, claims 1 and 7 have been changed in the manner that the Examiner courteously suggested in the paragraph bridging pages 3 and 4 of the Official Action of July 14, 2003.

In addition, claim 1 has been changed to recite that the covering member can be more easily stretched in a direction "away from" the skin contactable surface in the first zone than in the remaining zone as suggested by the Examiner on page 4 of the Official Action of July 14, 2003.

Entry of the changes to the specification and claims is respectfully requested.

In the paragraph bridging pages 2 and 3 of the Official Action of July 14, 2003 the Examiner has stated that the Substituted Specification filed October 9, 2002 as not been entered because it does not conform to 37 CFR §1.125.

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The Examiner stated that:

...contrary to Applicant's 1-20-3 remarks, 1.125(b)(2) requires a marked up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record (emphasis added), which in this case is the specification as amended 5-24-01, not the original specification as supplied by Applicant.

In response to the Examiner's request, applicant submitted a new Substitute Specification that complies with 37 CFR §1.125(b) together with a marked up copy of the Substitute Specification which shows deleted material struck out and added material underlined on October 14, 2003.

In accordance with the provisions of 37 CFR §1.125(b)(1), the undersigned stated that the Substitute Specification only includes the changes shown in the marked-up copy and does not include any new matter.

Entry of the Substitute Specification as submitted on October 14, 2003 is respectfully requested.

On page 3 of the Official Action of July 14, 2003 the Examiner had repeated paragraph no. 4 from the Official Action mailed July 10, 2002 (paragraph no. 1). It is believed that the Substituted Specification submitted October 14, 2003 addresses and overcomes this matter.

On page 3 of the Official Action of July 14, 2003 the Examiner had taken the position that the changes made to the second paragraph on page 3 of the specification introduce new matter into the specification. Accordingly, the Examiner will note that some of the language in the Substitute Specification reverts back to the original specification.

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Claims 1-7 stand objected to for a number of informalities that the Examiner had identified in the paragraph bridging pages 3 and 4 of the specification.

In response to this objection the changes which the Examiner had courteously suggested for the claims have been adapted in the present amendment.

Claim 1-6 stand rejected under 35 U.S.C. §112, first paragraph.

Under this rejection the Examiner had indicated that claim 1 requires that the covering be more easily stretched in a direction "towards" the skin contacting surface in the first zone than in the remaining portion thereof, while the original specification including Fig. 2 and 3 show a cover that is more easily stretched away from the skin contacting surface.

The Examiner' point seems to involve a debatable reference point. Nevertheless, claim 1 has been changed to recite that the covering member can be more easily stretched in a direction away from the skin contactable surface in the first zone.

Claims 1-3 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by European Patent Application No. 0 650 714 A1 to Divo et al., or in the alternative, under 35 U.S.C. §103(a) as being obvious over Divo et al. in view of U.S. Patent No. 5,846,232 to Serbiak et al. and U.S. Patent No. 4,655,760 to Morman et al.

Claims 4, 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Divo et al. alone or in view of Serbiak et al, Morman et al and U.S. Patent No. 5,853,881 to Estey et al.

Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Divo et al., Serbiak et al. and Morman et al.

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For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding rejections of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner had relied upon Divo et al. by referring to:

Figures 1-4, 6, 9-13, lines 31-39, col. 1, lines 3-16, col. 3, lines 52-55, col. 8, line 6-col 9, line 6 (Note definition of "nonwoven" in Materials Handbook provided in the last Office Action), col. 9, line 19-col 10, line 19, col. 12, line 20-col. 13, line 5, col. 14, lines 28-30, col. 15, line 42 -col. 16, line 4, i.e. the cover is 26, the previous sheet is 24, the core is 28, the elastic members are 32, the first layer is 5 or 11, the second layer is 3 or 7 and 15.

The Examiner stated that:

Figures 2-3, paragraph bridging cols. 8-9 and col. 6, lines 31-39 disclose the ratio set forth on lines 10-15 of claim 1.

The Examiner moreover stated that:

It is the Examiner's first position that col. 6, lines 31-39 also teach the structure of the lines 17-18 of claim 1 and claim 2.

And

Lines 15-17 and 18 et seq of claim 1, as best understood, note new matter rejection supra, recite function or capability of the claimed structure.

The Examiner concluded:

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The Divo device includes the same structure, see cited portions above. Therefore there is sufficient factual basis to conclude that the function or capability of the claimed structure is also inherent in the same structure of Divo.

Applicant's independent claim 1 recites, in part:

..said covering member consisting of an elastically stretchable first layer and an inelastically stretchable second layer formed of a plurality of continuous fibers, said continuous fibers being fixed to said elastically stretchable first layer in at least a pair of bonding zones spaced apart from each other so that a ratio of L/D, where L is a length of said continuous fiber fibers extending between said pair of bonding zones and D is a distance in a straight line between said pair of bonding zones, is larger in a first zone on said covering member than in a remaining zone,

Divo et al. does not teach a structure in which continuous fibers of an inelastically stretchable layer are fixed to an elastically stretchable layer "in at least a pair of bonding zones spaced apart from each other so that a ratio of L/D, where L is a length of the continuous fiber fibers extending between the pair of bonding zones and D is a distance in a straight line between the pair of bonding zones, is larger in a first zone on said covering member than in a remaining zone" as required by claim 1.

Divo et al. teaches an activated composite elastic member which comprises bonding an inextensible or unelongatable non-woven layer or film (3) to an elastically extendable layer (5) and "permanently elongating or rupturing the layer 3, which process is hereafter referred to as 'activation.'"

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In an alternative embodiment, Divo et al. teaches that "the unextendable layer 3 can be provided with a two-dimensional pattern of perforations, by which the layer is sufficiently weakened to become elongatable."

The Examiner had stated that:

Figures 2-3, paragraph bridging cols. 8-9 and col. 6, lines 31-39 disclose the ratio set forth on lines 10-15 of claim 1.

However, these portions of Divo et al. are completely silent about a ratio of L/D, where L is a length of the continuous fiber fibers extending between a pair of bonding zones and D is a distance in a straight line between the pair of bonding zones.

Divo et al. fails to teach applicant's L/D ratio which is a required element of applicant's claimed invention.

If anything the paragraph bridging columns 8 and 9 of Divo et al. teach that the stretching of the film causes a number of fibers to break, which would eliminate "continuous fibers" which are required by applicant's claims.

Thus, if anything, Divo et al. teaches away from applicant's claimed invention.

The Examiner's position that "there is sufficient factual basis to conclude that the function or capability of the claimed structure is also inherent in the same structure of Divo" is and unsupported allegation.

The Examiner makes reference to MPEP 2112.01.

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MPEP 2112.01 discusses chemical compositions, alloys (with similar corrosion resistance) and parachutes (with different panel configurations).

It is not believed that the teachings of Divo et al. can be relied upon MPEP 2112.01 as to shift the burden on applicant to disprove that the function of Divo et al. is similar or inherent to applicant's claimed function, particularly inasmuch as Divo et al. fails to teach applicant's claimed structure.

There are numerous composite articles that are configured in different manners to be stretchable in different regions. This does not mean that they all "inherently" have the same structure.

Note for example, Divo et al. specifically teaches different embodiments of the composite elastic member that have similar functions and different structures.

Note further the Examiner had relied upon each of Serbiak et al. and Morman et al. as teaching providing elasticity only to the transverse middle zone part of a diaper - using different structures.

Divo et al. does not teach a ratio of L/D, where L is a length of the continuous fiber fibers extending between a pair of bonding zones and D is a distance in a straight line between the pair of bonding zones.

Divo et al. teaches incorporating the composite elastic member in side panels and around margins of the leg openings. As taught, "[t]he amount of extensibility and the elasticity in the different elasticated areas of training pants 50 can be easily adjusted by varying the number and/or

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spacing of the parallel activation lines, or by adjusting the depth of the intermeshing rims and grooves of the rolls 41, 43" (column 17, lines 40-45) - which has nothing to do with varying the a ratio of L/D, where L is a length of the continuous fiber fibers extending between a pair of bonding zones and D is a distance in a straight line between the pair of bonding zones according to applicant's pending claims.

Contrary to the Examiner position, Divo et al. does not inherently teach applicant's claimed structure.

Moreover, Divo et al. does not teach the step in claim 6 of "stretching only a portion of said composite sheet in one direction so that said elastically stretchable first layer of said portion may be elastically stretched together with said continuous fibers."

It is submitted that there is no suggestion in Divo et al. of performing this selective stretching, particularly based upon the fact that Divo et al. teach incorporating the composite elastic member in side panels and around margins of the leg openings, rather than incorporating the elastic layer throughout the diaper and stretching only isolated portions.

The Examiner had relied upon each of Serbiak et al. and Morman et al. teach providing elasticity only to the transverse middle zone part of a diaper.

Estey et al. had been relied upon by the Examiner has teaching the interchangeability of elastic films and nonwovens of noncrimped fibers with elastic nonwoven webs of crimped fiber and the interchangeability of polyethylene nonwoven nonelastic for polypropylene or propylene copolymer nonelastic nonwovens.

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The Examiner's further reliance upon Serbiak et al., Morman et al. and Estey et al. does not address or overcome the deficiencies found in the teachings of Divo et al. as noted above.

Accordingly, the Examiner's further reliance upon Serbiak et al., Morman et al. and Estey et al. does not render applicant's claimed invention obvious.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicant's claimed invention. Moreover, the Examiner cannot properly rely upon the prior art under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

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If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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